

REMARKS

This amendment is submitted in response to the non-final Office Action mailed July 30, 2006. Following entry of this amendment, claims 1-17 and 19-23 remain pending in the application. Claims 1, 3 and 23 are independent. In the Office Action, the Examiner:

- objected to the Abstract for being written in “claim format,” rather than narrative form;
- objected to claims 3-5, 7-16 and 19-22 as improper multiple dependent claims;
- objected to claim 3 for informalities in claim 2, on which claim 3 depended;
- rejected claim 23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,711,232 to Fischer (hereinafter “Fischer”) as well as U.S. Patent No. 2,381,050 to Hardinge (hereinafter “Hardinge”);
- rejected claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,531,748 to de la Caffiniere (hereinafter “de la Caffiniere”) in view of Fischer; and
- indicated that claims 3 and 4 would be allowable if rewritten in independent form;.

Applicants have amended claims 1-17 and 19-23 to conform the claims to United States patent practice, remove all multiple dependencies, further define the invention recited, more clearly distinguish over the cited prior art, and/or conform with amendments to other claims. Claim 18 has been canceled. All amendments are fully supported by the originally-filed specification and/or drawings of the present application. No new matter has been added. The claim amendments made herein do not represent acquiescence in the Examiner’s rejections, but rather are made only to expedite prosecution of the present application and/or maintain consistency in claim language. Applicants expressly reserve the right to pursue the subject matter of any previously presented claims in one or more continuation applications. As discussed more fully below, Applicants respectfully submit that each of the currently pending claims define features that are not disclosed, taught or suggested by the prior art of record and respectfully requests allowance of same.

Specification

The Examiner objected to the Abstract as being written in “claim format.” To remedy this problem, Applicants have amended the Abstract to appear in narrative form, and have removed reference numerals. Applicants respectfully request withdrawal of this objection.

Applicants also submit herewith a clean substitute specification (Appendix A) incorporating amendments to conform the application to United States practice and correct minor grammatical and translation errors. A marked-up copy of the specification (Appendix B) showing all changes relative to the originally-filed specification is also included. Applicants respectfully request that the substitute specification be made of record in this application.

Claim Objections

Claims 3-5, 7-16 and 19-22 were objected to as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. Applicants have amended the claims to remove all multiple dependencies, and respectfully request that these objections be withdrawn.

Claim 3 was objected to for informalities in claim 2, which had recited a “cylindrical all prismatic shaft.” Claim 2 has been amended to remove the offending language, so Applicants also request that this objection to claim 3 be withdrawn.

Claim Rejections – 35 U.S.C. §102(b)

Claim 23 was rejected under 35 U.S.C. § 102(b) as anticipated by both Fischer and Hardinge. In response, claim 23 has been amended to recite “a bone fixation implant” and include the patentable subject matter of original claim 3 — first and second expandable sheaths formed at the first end of the recited implant body. Both Fisher and Hardinge fail to disclose the bone fixation implant recited in amended claim 23. Accordingly, Applicants respectfully request that the anticipation rejection be withdrawn, and that claim 23 be allowed.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1 and 2 were rejected as obvious under 35 U.S.C. § 103(a) over de la Caffiniere in view of Fischer. As the Office Action states, De la Caffiniere at least fails to disclose an elastically expandable bone fixation element and a sheath that can be elastically expanded at the front end. (July 31, 2006 Office Action at 5.) The Examiner cites Fisher as teaching an expandable sleeve for use with bone screws, and states that it would have been obvious “to manufacture the device of de la Caffiniere with the sleeve of Fischer in order to enhance the connection and holding of the screw and sleeve in the bore of the bone.” (*Id.* at

5.)

Fisher discloses a sleeve that is inserted into bone “before the screw is driven into it to swell its inner portion and lock it even better in the bore,” such that the sleeve is a separate element from the bone fixation screw. (Fisher at col. 2, ll. 5-10.) The combination of de la Caffiniere with Fisher fails to disclose, teach or suggest the bone fixation device including, *inter alia*, a bone fixation implant having “a front end configured and adapted to engage bone, a rear end, a shaft, and *a first elastically expandable sheath formed at the front end of the bone fixation implant*, the bone fixation implant adapted for insertion through the transverse borehole along the central borehole axis, wherein the expandable sheath of the bone fixation implant is configured and adapted for *optional expansion in at least one direction transverse to the central borehole axis after the bone fixation implant has been anchored in bone*, and at least a portion of the shaft remains within the transverse borehole of the intramedullary pin after the bone fixation implant has been anchored in bone.” The structure shown in de la Caffiniere and Fisher, even if combined, fails to include each of the recited limitations in amended claim 1.

Accordingly, Applicants respectfully request that the obviousness rejection of claim 1 be withdrawn, and that claim 1, and each of its dependent claims 2, 4, 10-17, and 19-22, be allowed.

Allowable Subject Matter

Applicants wish to thank the Examiner for the indication of allowable subject matter in claims 3 and 4. Claim 3 has been rewritten in independent form to include the subject matter of original base claim 1 and original intervening claim 2. Accordingly, Applicants respectfully request allowance of claim 3, and its dependent claims 5-9.

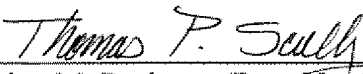
In view of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider pending claims 1-17 and 19-23 with a view towards allowance. The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

A separate petition for a one-month extension of time is submitted herewith. Should any additional fees be required, please charge such fees to Jones Day deposit account no. 50-3013.

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Respectfully submitted,

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